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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,035	07/07/2003	Brett Thomas	2914-0103	9402
6449	7590	11/18/2005	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			FETSUGA, ROBERT M	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/613,035	Applicant(s) THOMAS ET AL.	
	Examiner Robert M. Fetsuga	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/25/04 & 10/11/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-61 and 68-89 is/are pending in the application.
- 4a) Of the above claim(s) 32,57,70,74,78-83,86 and 87 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-31,33-56,58-61,68,69,71-73,75-77,84,85,88 and 89 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/07/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's election without traverse of Group II, Species I, Sub-species C, in the reply filed on August 25, 2004 is acknowledged. It is noted at least claims 29-34, 39, 45-47, 53 and 71 are not "generic" contrary to applicant's statement in the reply.

2. Claims 32, 57, 70, 74, 78-83, 86 and 87 are objected to as not encompassing the elected embodiment where applicant's state the contrary in the responses filed August 25, 2004 and October 11, 2005. Claim 32 recites an "above ground pool". Fig. 1 is an in-ground pool (pg. 5 ln. 9). Claim 57 recites a "water playing device" which is not associated with any embodiment. Claim 70 recites a "fountain" which is not associated with any embodiment. Claim 74 depends from claim 70. Claims 78-83 recite a "remote water sensor" which is associated with the embodiments of Figs. 2-4. Claim 86 depends from claim 70. Claim 87 depends from claim 83. Accordingly, claims 32, 57, 70, 74, 78-83, 86 and 87 are withdrawn from further consideration pursuant to 37 CFR 1.142(b).

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "steps" set forth in claim 30, "ladder" set forth in claim 31, "concrete bottom and side walls" set forth in claim 34, "base" set forth in claim 39, subject

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matter set forth in claim 42, "natural item" set forth in claim 47, "timer mechanism" set forth in claims 51 and 54, "means for setting" set forth in claim 52, subject matter set forth in claims 55 and 56, "portable" feature set forth in claim 61, "stream directing means" set forth in claim 69, "control means" set forth in claims 72, 73, 75-77, 84 and 85, "handheld remote unit" set forth in claims 84 and 85, and "control unit" set forth in claims 88 and 89, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR

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1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Proper antecedent basis for the "water outlet" set forth in claims 28, 61, 68 and 69, "supply source of water" and "water conduit" set forth in claim 28 (described as same element at pg. 6 ln. 19), subject matter set forth in claims 35-38, 40 and 41, "blend in with the landscaping" language set forth in claim 47, "means for determining" (both occurrences) set forth in claim 48, "means for setting" set forth in claim 52, "replenishing unit", "designed for location" subject matter, "stream directing means" and "value means" set forth in claim 69, "valve means" and "control means" set forth in claims 72, 73, 75-77, 84 and 85, and "control unit" set forth in claims 88 and 89, could not be found in the specification. Applicant is reminded claim terminology in mechanical cases should appear in the descriptive portion of the specification by reference to the drawing(s).

5. The amendment filed May 17, 2004 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The subject matter added to pages 3, 6 and 11.

Applicant is required to cancel the new matter in the reply to this Office Action.

6. Claims 28-31, 33-40, 42-47, 55, 56, 58-61, 68, 71, 72, 75, 76, 84 and 88 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 28 recites transmitting water "laterally" into a body of water. Claim 68 recites similar subject matter.

Implementation of this subject matter is neither taught by the instant disclosure nor evident to the examiner. The trajectory would appear to be arcuate as well, rather than only lateral, as gravity would affect the trajectory.

7. Claims 28-31, 33-47, 55, 56, 58-61, 68, 69 and 71 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for replenishing an amount

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of water corresponding to a predetermined amount of depleted water, does not reasonably provide enablement for only replenishing a corresponding amount of depleted water. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

8. Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim recites a base "that rests at a level substantially equal to a top of a perimeter wall".

Implementation of this subject matter is neither taught by the instant disclosure nor evident to the examiner.

9. Claim 40 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim recites an inclination between "horizontal" and "vertical". Implementation of this subject matter is neither

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taught by the instant disclosure nor evident to the examiner. The end points of 0 and 90 deg. would not appear capable of producing the disclosed trajectory.

10. Claims 42 and 69 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 42 recites an "adjustable" discharge outlet. Claim 69 appears to recite similar subject matter (stream directing means). Implementation of this subject matter is neither taught by the instant disclosure nor evident to the examiner.

11. Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim recites a patio area "substantially free from obstruction from between said discharge unit and said pool". Implementation of this subject matter is neither taught by the instant disclosure nor evident to the examiner. It would appear at least the water trajectory would strike a person positioned between the discharge device and pool.

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12. Claims 58-60 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 58 recites "said discharge unit is entirely separate from a water filtration system". Claims 59 and 60 recite similar subject matter. This subject matter is not found in the originally filed disclosure and is therefore considered to be new matter. In fact, these claims appear to contradict the original disclosure at page 15, lines 2-5.

13. Claim 61 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim recites a "portable" discharge unit. Implementation of this subject matter is neither taught by the instant disclosure nor evident to the examiner.

14. Claims 72, 73, 75-77, 84, 85, 88 and 89 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 72 recites "control means". Claims 73, 75, 84 and 85 recite similar subject matter. Implementation of this subject matter is neither taught by the instant disclosure nor evident to the examiner.

15. The claim hierarchy does not appear to be in accordance with MPEP 608.01(m). Claims remaining at allowance may require renumbering.

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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17. Claims 28, 29, 33-44, 51, 52, 55, 56, 58-61, 68, 69 and 71-73, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Babcock.

The Babcock reference discloses a system/apparatus/device comprising: a swimming pool 11 including a depleting body of water, and a patio area 12; a discharge/replenishing unit 46 including an inlet (receiving 45), an "adjustable" 58 outlet 52, and a base 50; a source of water/water conduit 20,45; a valve (means) 30; and a timer mechanism/control means 33,39, as claimed. Re claim 58, the discharge unit can be "entirely separate from a water filtration system (col. 2 lns. 17-22).

18. Claims 35-38, 55 and 56, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Babcock.

Re claims 35-38, the choice of lateral displacement would appear an obvious choice to be made. Re claims 55 and 56, the choice of pool depth would appear an obvious choice to be made.

19. Claim 30, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Babcock and Stillman, Jr.

Although the body of water of the Babcock swimming pool does not include steps, as claimed, attention is directed to the Stillman, Jr. (Stillman) reference which discloses an analogous swimming pool 10 which further includes a body of water having steps (Fig. 1). Therefore, in consideration of Stillman, it

would have been obvious to one of ordinary skill in the swimming pool art to associate steps with the Babcock body of water in order to facilitate access.

20. Claim 31, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Babcock and Smith.

Although the body of water of the Babcock swimming pool does not include a ladder, as claimed, attention is directed to the Smith reference which discloses an analogous swimming pool (col. 1 ln. 7) which further includes a body of water having steps (col. 1 lns. 39-44). Therefore, in consideration of Smith, it would have been obvious to one of ordinary skill in the swimming pool art to associate a ladder with the Babcock body of water in order to facilitate access.

21. Claims 45-47, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Babcock and Williams.

Although the discharge unit of the Babcock swimming pool does not include a natural item shape, as claimed, attention is directed to the Williams reference which discloses an analogous swimming pool 10 which further includes a discharge unit 18 having a natural item shape (Fig. 8). Therefore, in consideration of Williams, it would have been obvious to one of ordinary skill in the swimming pool art to associate a natural

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item shape with the Babcock discharge unit in order to provide ornamentation.

22. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


23. Claims 48-50 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 46-48 of prior U.S. Patent No. 6,611,968. This is a double patenting rejection.

24. Claims 28-31, 33-47, 51-56, 61, 68, 69, 71-73, 75-77, 84, 85, 88 and 89 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-30, 32-46 and 49-54 of U.S. Patent No. 6,611,968.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are anticipated by the patented claims, and anticipation is the epitome of obviousness.

25. Applicant is referred to MPEP 714.02 and 608.01(o) in responding to this Office action.

26. Any inquiry concerning this communication should be directed to Robert M. Fetsuga at telephone number 571/272-4886 who can be most easily reached Monday through Thursday. The Office central fax number is 571/273-8300.


Robert M. Fetsuga
Primary Examiner
Art Unit 3751